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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,183	03/15/2002	Yasuyuki Kanada	4325/PCT	8903

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EXAMINER

PETERSON, KENNETH E

ART UNIT PAPER NUMBER

3724

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/088,183	Applicant(s) KANADA ET AL.	
	Examiner Kenneth E Peterson	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,8-11 and 14-23 is/are pending in the application.
- 4a) Of the above claim(s) 8-11 and 15-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,14 and 19-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 mar 02 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1,2,14,19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of the Kanada patents (EP0940215, US 6,155,755) in view of either Colding (US 3,369,283) or Littecke et al. (US 5,598,621).

Both of the Kanada patents show in figure 4 an indexable insert having all of the recited limitations except that the tool substrate (4) between the sintered bodies (1,1) is only about 25% of the thickness of the rest of the tool substrate, as opposed to the 30%-90% required by most of the claims, or the 32.8%-87.3% required by claim 23.

However, in the art of indexable inserts, both Colding and Littecke show that it is well known to for the portion of the tool substrate between the sintered bodies to be between 32.8%-87.3% of the thickness of the rest of the tool substrate.

It is noted that the courts have long ruled that *when the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation*. See In re Aller, 105 USPQ 233. Aller also stated that *even though Applicant's modification results in great improvement and utility over the prior art, it may still not be patentable if the modification was within the capabilities of one skilled in the art*. In this case, one of ordinary skill would see Kanada, Colding and Littecke and note that a wide variety of thicknesses are known for the tool substrate between the bodies. This person of ordinary skill would then

experiment to determine the proper thickness of the tool substrate between the bodies, and arrive at the conclusion that the thicknesses shown by Colding and Littecke were acceptable for Canada.

It would have been obvious to one of ordinary skill in the art to have modified either of the Kanada devices by making the portion of the tool substrate between the sintered bodies thicker, as suggested by both Colding and Littecke, since they are both art recognized equivalents known for the same purpose (see MPEP 2144.06) and since it is obvious to experiment with such thicknesses.

3. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that his insert (and those of the Kanada references) are "non-integral", whereas the Colding and Littecke inserts are "integral". This point is not appreciated by the Examiner, perhaps because of the terminology use by Applicant. Examiner is of the opinion that any person of ordinary skill would look at Applicant's device and say it was "integral", since it is not something that one could readily separate.

Applicant states that Colding's and Littecke's bodies are not brazed, and therefore they are non-analogous art. Examiner disagrees. The art of indexable inserts having opposed cutting corners is a narrow and confined art, containing the above three references and only a few dozen additional patents, and it is very reasonable to say that those skilled in the art would be familiar with these inserts and note what substrate thicknesses are suggested by them. The fact that Colding's and Littecke's bodies are

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not brazed does not effect the teachings of how thick the tool substrate must be to support the bodies. Furthermore, references such as Nakamura, hereby made of record, show that even brazed bodies can be quite thin to leave a larger tool substrate thickness.

Applicant notes that Colding's and Littecke's specifications are silent on how thick the substrate should be, and moreover than there is no literal suggestion to make Kanada's tool substrate thicker. However, it has long been held that references should be given weight for what the drawings would suggest to one of ordinary skill. See In re Seid 73 USPQ 431 or In re Meng et al. 18 USPQ 94. In this case, Colding's and Littecke's drawings clearly show a substrate thickness well within Applicant's claimed range, and this would suggest to one of ordinary that this substrate thickness is something that could be experimented with and that a tool substrate thickness within Applicant's claimed range would be acceptable for Kanada.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Peterson whose telephone number is 703-308-2186. The examiner can normally be reached on Monday thru Thursday between 7am and 4pm.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9306. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

kp
April 14, 2004



KENNETH E. PETERSON
PRIMARY EXAMINER